

REMARKS

Claims 1-31 are pending in the application. Claims 1, 6, 10, 14, 19, 24 and 29 are independent. By the foregoing Amendment, second claim 5 through claim 30 have been renumbered to claims 6-31, and resulting claims 1, 6, 10, 14, 24 and 29 have been amended. These changes are believed to introduce no new matter and their entry is respectfully requested.

Objection to Claim 5

In the Office Action, the Examiner objected to claim 5 citing informalities. By the foregoing Amendment, Applicants have amended the claims to accommodate the Examiner. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the objection to claim 5.

Rejection of Claims 1-30 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. US 2004/0044817 to Thurlo et al. (hereinafter “Thurlo”) in view of U.S. Patent No. 6,728,808 to Brown et al. (hereinafter “Brown”). To establish a *prima facie* case of obviousness, an Examiner must show that that there is some suggestion or motivation to modify a reference to arrive at the claimed invention, that there is some expectation of success, and that the cited reference teaches each and every element of the claimed invention. (MPEP §2143.) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Applicants respectfully traverse the rejection.

Representative claim 1 recites in pertinent part “a peripheral component interconnect (PCI) standard hot-plug controller (SHPC) having: a first register coupled to store *a first and a second* PCI slot operation *command*, the second PCI slot operation command being different from the first PCI slot operation command; and a second register coupled to the first register, the second register to store *a first value and a second value* for a timing parameter in a signal sequence *for execution of the first and second* PCI slot operation *commands*, the second value being different from the first value” emphasis added.

Applicants respectfully submit that Thurlo and/or Brown either alone or in combination fail to teach or fairly suggest at least these elements of claim 1. The Examiner asserts that Thurlo teaches a PCI SHPC and a first register to store two different PCI slot operation commands. The Examiner concedes that Thurlo fails to teach a second register in a SHPC to store two different values for a timing parameter in a signal sequence used to execute the two different slot commands. The Examiner cites Brown for teaching a timing value stored within a programmable retry register and argues that the timing value can represent any specific interval of time. The Examiner then concludes that it would have been obvious to incorporate Brown's teaching into Thurlo's system to optimize transaction signal retries between a PCI bus master and a target device. Applicants respectfully disagree.

Thurlo appears to be directed to a method of detecting the frequency of one or more devices connected to expansion slots associated with a PCI bus. Thurlo does not appear to teach or fairly suggest a *standard* hot plug controller. Brown appears to be directed to dynamically optimizing transaction retries issued by a PCI bus master device to a target device. Thurlo does not appear to teach or fairly suggest a hot plug controller, let alone a *standard* hot plug controller. Thus at least this element is not taught or fairly suggested by the combination of Thurlo and Brown.

Also, assuming for the sake of argument that Thurlo and Brown could be combined, the law also is clear that the mere fact that references can be combined is not sufficient to establish a *prima facie* case of obviousness unless the reference teachings also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Examiner must show at least some degree of predictability. *In re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976). Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness because there is no reasonable expectation of success.

Applicants respectfully submit that if Thurlo and Brown were combined, one of ordinary skill in the relevant art would not predict that the result would be a programmable timing parameter for a signal sequence for execution of PCI slot operation commands. The Examiner states that it would have been obvious to incorporate Brown's teaching into Thurlo's system to

optimize transaction signal retries between a PCI bus master and a target device. However, the Examiner provides no clear line of reasoning as to how Thurlo would further optimize transaction signal retries between a PCI bus master and a target device in Brown. The Examiner merely states that Thurlo would do this. The Examiner also provides no clear line of reasoning as to how combining Thurlo and Brown would successfully result in a programmable timing parameter for a signal sequence for execution of a PCI slot operation command. Moreover, one definitely would not predict that combining Thurlo and Brown would result in a programmable timing parameter for a signal sequence for execution of two different PCI slot operation commands. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 1-30.

CONCLUSION

Applicants submit that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

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